

REMARKS

A. Status of the Claims

Claims 1-48 were originally filed. In the Supplementary Preliminary Amendment dated December 20, 2001, claims 1-17 and 22-48 were canceled and claims 49-113 were added. Due to a restriction Requirement dated January 10, 2002, Appellants elected without traverse to prosecute Group 1, claims 18-21 and 49-64 drawn to a method of screening for a modulator of calpain function in a Response to the Restriction Requirement filed April 8, 2002. Claims 18-21 and 49-64 were pending prior to the Office Action dated October 16, 2002. Claim 114 was added in the response to the Office Action dated January 16, 2003. Claims 115 and 116 are added in the present response. Therefore, the claims pending are claims 18-21, 49-64 and 114-116.

Present issues on appeal are the rejection of (1) claims 18-21 and 54 as being indefinite under 35 U.S.C. 112, second paragraph related to the recitation of "standard activity;" (2) claims 18-21, 49, 51, 53-55, 57-60 as being indefinite under 35 U.S.C. 112, second paragraph relative to the recitation of "calpain 10;" (3) claim 53 as being indefinite under 35 U.S.C. 112, second paragraph relative to its dependency on claim 52; (4) claims 19 and 53 for lack of written description under 35 U.S.C. 112, first paragraph for the phrase "amino acids 1-47 of SEQ ID NO:2;" (5) claims 18-21, 49-51, and 53-64 for lack of written description under 35 U.S.C. 112, first paragraph for the phrase "calpain 10;" and (6) claims 18-21, 49-51, and 53-64 for lack of enablement under 35 U.S.C. 112, first paragraph regarding the method of screening for inhibitors of calpain 10 molecules. With the entry of the current amendment issues 1 and 3 above will longer require appeal.

B. Amendment of claims 18-21 and 54

The final Office Action dated March 26, 2003 rejects claims 18-21 and 54 as being indefinite due to the recitation of the phrase "standard activity profile." The phrase "standard activity profile" in claims 18, 49, 54, 55 and 57 has been amended to read "activity profile." Support for this amendment can be found at least on pages 87-94 of the specification. Thus, entry of this amendment will reduce the issues on appeal as set forth in the concurrently filed Appeal Brief.

C. Amendment of claim 53

The final Office Action dated March 26, 2003 rejects claim 53 as being indefinite for depending from claim 52. Claim 53 has been amended to depend from claim 51, which claim 53 further limits, instead of claim 52. Thus, this rejection is rendered moot and reduces the issues on appeal.

D. New claims 115 and 116

New claims 115 and 116 are directed specifically to human calpain 10. Applicants respectfully request the addition of the new claims on the grounds that the new claims present aspects of the invention in an allowable form. Examiner's implication is that these claims may be allowable.

E. Conclusion

Appellants have submitted amendments that are believed to substantially reduce the issues on appeal and place the claims in condition for allowance.

Respectfully submitted,

Michael P. Landrum (51,898) for:
Charles P. Landrum
Reg. No. 46,855
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
713-651-5391

Date: December 8, 2003